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IN THE

Supreme Court of the United States

October Term, 1968

No. ~~1011~~

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ANDERSON'S-BLACK ROCK, INC.,

Petitioner,

against

PAVEMENT SALVAGE CO., INC.,

Respondent.

PETITIONER'S BRIEF

Writ of Certiorari to the United States Court
of Appeals for the Fourth Circuit

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INDEX

	PAGE
I. Opinions Below	1
II. Statement of the Grounds on Which Jurisdiction of This Court Is Invoked	2
III. Constitutional Provisions, Statutes and Rules Involved	2
IV. Questions Presented for Review	4
V. Statement of the Case	5
A. Proceedings in This Case	5
B. Nature of Patent in Suit	6
VI. Argument	7
Aggregation in Patent Law	7
New Use of a Known Machine	10
Extension of the Patent Monopoly	13
Commercial Success and the Claimed Invention	15
Old Combination	18
VII. Conclusion	18

Cases Cited

A & P Tea Co. v. Supermarket Corporation, 340 U. S. 147	5, 8, 9, 15
---	-------------

	PAGE
American Tube and Controls, Inc. v. General Fittings Company, 161 USPQ 1 (CCA1)	13
Baldwin Lima Hamilton Corp. v. Hi-Way Equipment Co., 250 F. Supp. 574	8, 9, 15
Bassick Mfg. Co. v. R. M. Hollingshead, 298 U. S. 415	18
Cuno Engineering Corp. v. Automatic D Corp., 314 U. S. 84	12
Graham v. John Deere & Co., 383 U. S. 1	5, 15
Jungersen v. Ostley and Barton Co., 335 U. S. 560 ..	16
Kaiser Industries Corp. v. McLouth Steel Corp., 400 F. 2d 36, headnotes 4 and 10	16
Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545	4, 7, 8, 10, 13, 14
Murdock v. Murdock, 176 F. 2d 434 (4th Circuit) ...	9
Richards v. Chase Elevator Co., 158 U. S. 299	10
Toledo Pressed Steel Co. v. Standard Parts, 307 U. S. 350	9, 16
Young v. John McShain, 130 F. 2d 31 (4th Circuit) ..	9

Statutes Cited

28 U. S. C. 1254(1)	2
35 U. S. C. 100(b)	3, 11

	PAGE
35 U. S. C. 103	3
Constitution of the United States, Article I, Section 8	2

Other Authorities Cited

Rules of the Supreme Court of the United States, Rule 19(1)(b)	4
Deller's Walker on Patents, Second Edition:	
Section 27	10
Section 124	13



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PETITIONER'S BRIEF

**Writ of Certiorari to the United States Court
of Appeals for the Fourth Circuit**

Petitioner, Anderson's-Black Rock, Inc., defendant below, respectfully prays for the reversal of the judgment and order of the Court of Appeals for the Fourth Circuit, entered November 6, 1968.

I

Opinions Below

Opinion and mandate of the Fourth Circuit Court of Appeals, Appeal No. 12,020, November 6, 1968, 404 F. 2d 450 (A. 1a).

Opinion of the District Court, S. D. W. Va., July 25, 1967, on motion for new trial, not reported (A. 15a).

Opinion of the District Court, S. D. W. Va., March 23, 1967, holding patent in suit invalid, not reported (A. 16a).

II

Statement of the Grounds on Which Jurisdiction of This Court Is Invoked

Sought to be reviewed is the decision and mandate of the Fourth Circuit Court of Appeals, dated and entered November 6, 1968. Jurisdiction to review by writ of certiorari is believed conferred by 28 U. S. C. 1254(1).

III

Constitutional Provisions, Statutes and Rules Involved

Constitution of the United States, Article I, Section 8 (1787):

Section 8. The Congress shall have Power . . .

. . .

To regulate Commerce with foreign Nations, and among the Several States, and with the Indian Tribes;

. . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discovering;

. . .

Act of June 25, 1948; c. 646; 62 Stat. 928; *Title 28, United States Code, Section 1254:*

Section 1254. Courts of appeals; certiorari; appeal; certified questions.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

• • •

35 U. S. C. 100(b)

When used in this title unless the context otherwise indicates—

• • •

(b) The term “process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

• • •

Patent Act of July 19, 1952; Public Law 593, 82nd Congress, 2d session; c. 950; 66 Stat. 792; Title 35, United States Code, Section 103:

Section 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rules of the Supreme Court of the United States

PART V. JURISDICTION ON WRIT OF CERTIORARI

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI

* * *

1. (b) Where a court of appeals . . . has decided a federal question in a way in conflict with applicable decisions of this court; . . .

* * *

IV

Questions Presented for Review

1. Court of Appeals has decided a federal question in a way which is in conflict with applicable decisions of this Court.

A question below and the principal question here is whether the holding on the matter of aggregations in patents in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 is still the law and, if so, whether the majority decision of the Fourth Circuit Court of Appeals is in conflict therewith and whether certiorari should be granted under Rule 19(1)(b) of the Rules of the Supreme Court on that account?

2. Aggregation in this case.

Is the holding in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, defining aggregation in the patent law and determining that mere aggregation is not patentable invention applicable to the factual situation in the present case?

3. Validity of patents claiming aggregation as being affected by long felt want and commercial success.

Assuming that mere aggregation alone cannot result in patentable invention and considering the rather limited role in patent law played by such factors as long felt want and commercial success in determining patentability under the holdings of *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147, and *Graham v. John Deere Co.*, 383 U. S. 1, may aggregation coupled with commercial success result in a valid patent?

4. Proof of Commercial success.

Is proof of success of one element of a patented combination relevant to the commercial success of the entire combination?

V

Statement of the Case

A. Proceedings in This Case

On August 28, 1963 respondent instituted the present action against petitioner for infringement of Neville patent 3,055,280, the patent in suit. Trial was held on April 19 and 20, 1965. In a written opinion the trial Judge held the patent invalid, not reaching the issue of infringement. A petition for rehearing was subsequently denied and appeal to the Circuit Court of Appeals followed. Argument was held April 3, 1968 and the Appeal was decided November 6, 1968. The Circuit Court of Appeals reversed the District Court on the validity issue and remanded the case for trial on the infringement issue. The remand was stayed by order of the Circuit Court on November 27, 1968 to permit a petition for writ of certiorari to be filed in the Supreme Court. Petition was granted March 24, 1969.

B. Nature of Patent in Suit

The Neville patent in suit discloses and claims a road building machine. There is not claimed a new use for an old machine in terms of process under 35 U. S. C. 100(b), nor a process in conventional form for building a road. The machine is a paver on the side of which is suspended a radiant energy generator. Claims for a road building process and for a radiant energy generator were included in Neville's application for the patent as originally filed in the Patent Office but were subsequently abandoned during its *ex parte* prosecution (A. 52a). The paver is entirely conventional and is used, for example, to receive hot bituminous material in its hopper, spread the material on a previously prepared road base upon which the paver travels and thereafter to shape the mix to a desired contour. As stated in the Neville patent, the type of radiant energy generator which is hung from the paver is illustrated in prior art patent 2,775,294 to Schwank (Def. Ex. 4). This type of generator is principally characterized as one having a perforated lower plate through which fuel is burned in a manner to heat the plate which then becomes a source of radiant or infra-red heat. The claims in the Neville patent define in broad terms such a generator in association with paver means for placing and shaping a pavement material which in most of the claims is identified as bituminous. Such paving means include the usual screed and reciprocating tamper for leveling and smoothing the pavement material deposited by a hopper and the paver's pneumatic tires for compacting the thusly laid and shaped road material.

As explained in the Neville patent the radiant energy generator is employed for two purposes—one for conditioning an old road surface to receive new paving material on top thereof and secondly to condition a side edge of a

recently laid strip of material for bonding a second strip thereto in side to side relation, the bonded strips thus constituting abutting lanes of a highway.

VI

ARGUMENT

Aggregation in Patent Law

The reason urged by Petitioner for reversing the Court of Appeals is that the holding by it decides "a federal question in a way in conflict with applicable decisions of this court". Rule 19(1)(b) of the Rules of the Supreme Court of the United States. The applicable decision in this instance is found in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545. In the dissenting opinion below Circuit Judge Craven states that the majority "ignores the teaching of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549 (1939) relied upon by the district court."

The definition of aggregation is clearly stated in the *Lincoln Engineering* decision and is quoted in the district court and Court of Appeals dissenting opinions below. The *Lincoln Engineering* decision then concludes as follows:

"We conclude that Butler's [the patentee's] effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements *having no new function when operated in connection with the coupler renders the claim void.*"

A recognition of merely those facts which are set forth in the Neville patent compels a determination that the

holding in *Lincoln Engineering* is applicable to them. It is easily seen and never disputed by respondent that the "old parts" namely the claimed pavement shaping means, as for example the hopper, screed, tamper and pneumatic tires of the old paver, all operate in precisely the same manner with no new or modified function whether or not the improved and previously patented radiant energy generator is present. The latter is changed neither in its structure nor in its operation and function as a consequence of its association with the old paver. Indeed, whatever definition of aggregation may be employed, and it has been stated in many forms over the years, such definition would be obviously applicable to the facts at hand.

The "improved form" of radiant energy generator which is the only structure claimed in Neville aside from the conventional paving components mentioned above is shown generally, including the positively claimed "perforate member" or "perforate lower surface", in the Schwank patent 2,775,294. All the *claimed* elements are, therefore, old which is readily conceded by respondent.

If the question as to whether the rule against aggregation in patent law is to be retained is to be determined by considering whether the association together of the old components would have been obvious under 35 U. S. C. 103, then the judicial admonitions regarding the probability against invention where the elements are all old though otherwise in a proper combination, as opposed to the aggregation here, may be material. Such are to be found in *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147; *Baldwin Lima Hamilton Corp. v. Hi-Way Equipment Co.*, 250 F. Supp. 574 and cases cited therein under headnote 3.

The Supreme Court has continued to follow the *Lincoln Engineering* doctrine in condemning patents claiming ag-

gregation. See *Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350, 356; *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 151. In the former decision the Court was considering the claimed combination of a special but well known flame torch and a cap for the torch to prevent extinguishment of the flame by wind and rain. The cap was also old as having been used on other type flame torches. The Court ruled that since the cap was serving the same function as it always had without being in any way changed in function or structure due to the torch and the latter continued to produce the same luminescent flame as before, the patent covering the device claimed mere aggregation and was for this reason invalid. The Court of Appeals in not applying this reasoning to the fact situation before it, namely a separately functioning street paver and radiant energy burner supported thereon which continue to function in the claimed association identically as they had individually and prior to such association is in obvious conflict with the decisions of the Supreme Court since the decision in *Lincoln Engineering*.

The district courts around the country have faithfully followed the *Lincoln Engineering and A & P Tea Co.*, holdings in condemning patent claims which recite an aggregation of parts. By way of example see *Baldwin-Lima Hamilton Corp. v. Hi-Way Equipment Co.*, 250 F. Supp. 574, 580-581.

The decision of the Court of Appeals below is also in clear conflict with its own prior decisions involving aggregation claims in patents. For example, see *Murdock v. Murdock*, 176 F. 2d 434 (4th Circuit), citing *Young v. John McShain*, 130 F. 2d 31 (4th Circuit), in which Judge Parker presents "an elaborate citation of authorities" holding patents invalid for claiming aggregation including

the decision in *Richards v. Chase Elevator Co.*, 158 U. S. 299, 302 wherein the Supreme Court said as follows:

"So long as each element performs some old and well known function, the result is not a patentable combination, but an aggregation of elements."

Even the respondent does not and cannot argue the undisputed fact here that each element recited in the Neville patent claims, namely, the generator for heating the bituminous material and the paving means for depositing and shaping this material "performs some old, and well known function" undisturbed by the presence of the other recited elements. Clearly the sole purpose for hanging the generator onto the side of the old paver shown in the patent was one of convenience. The claims are therefore clearly directed to an aggregation of elements and are invalid.

It is urged that the Supreme Court should reaffirm its decision in *Lincoln Engineering Co.* On the basis of such reaffirmation, petitioner asks that the judgment of the Court of Appeals, which is obviously at variance with that decision, be reversed.

Additional authorities under the heading, *Mere aggregation of elements not invention*, are contained in Deller's Walker on Patents, Second Edition, Section 27.

New Use of a Known Machine

A reason for retaining the present stricture against patenting aggregations may be found, in the opinion of petitioner, in the language of a provision in the present patent statute. Petitioner alludes in this respect to 35 U. S. C. 100(b) which refers to a new use of an old machine. It reads as follows:

“The term ‘process’ means process, art or method, and includes a new use of a known . . . machine . . .”

The Neville patent claims are addressed to a machine, not a method or process for using a known machine. The single most important component in the machine is the radiant energy generator, the particular form of which was known to the art. If it be assumed that Neville had discovered a new use for the generator in the road construction industry, he was in a position to obtain patent protection through method claims directed to such use. However, by directing his claims to apparatus, which includes the generator in loose association with ordinary street paving components, he not only was thus claiming improper aggregation but was violating the noted statutory provision which sets forth the proper manner of obtaining patent protection in such situations.

If at any time in the future some one discovers a new use for an old device and patents the device separately in conjunction with the needed elements required to give it utility in the new field, he would in many instances have to claim aggregation. By doing so the patent will most probably have novel subject matter as far as the patent art is concerned, but denies a possible patentee of the old device from enjoying all the expected fruits of his creation. Such a proceeding if allowed would entitle anyone to in effect repatent the old device by combining it with those components required to make it useful in a given field. On the face of it a completely different ensemble ensues thereby seemingly easily passing the test of obviousness established in 35 U. S. C. 103 but at the same time limiting the value of the patent on the old device to the patentee who would be precluded from exploiting his invention in

what would possibly be its normal commercial areas or their logical extension. The new ensemble, if claimed as a mere catalogue or aggregation of functionally disassociated elements in the patent of the one who is first to contrive it, as in the instant case, would require no unordinary skill in the making but merely an appreciation of its utility in a selected area of endeavor. Under these circumstances, to predicate patentability on novelty and utility alone would without any question defy the letter and spirit of 35 U. S. C. 103 which requires that the subject matter itself be non-obvious as a condition for patentability. If, on the other hand, he is required to patent the new use of the old device in terms of process instead of apparatus, the question of obviousness would have to be squarely met and the burden would be on applicant for the process patent to show that such use of the old device was unobvious under 35 U. S. C. 103 and that its utility as so used was clearly unexpected considering the entire background and evolution of the invention in the old device and the natural environment for it about which the patent covering the device speaks either expressly or by obvious implication.

That a new use or application of an old device may not be patented when no more than the mere mechanical skill of the art was required to make the adaptation was held in *Cuno Engineering Corp. v. Automatic D Corp.*, 314 U. S. 84. In light of *Morcom* patent 799,014 which teaches the benefits of utilizing radiant energy to make an improved asphalt joint there is grave doubt that even had Neville claimed a new use for the Schwank type radiant energy generator, in terms of process or method in accordance with 35 U. S. 100(b), patentable invention would result notwithstanding the factor of commercial success found by the Court of Appeals. In any event it is apparent that since Neville, if he had discovered anything,

was the first to use a Schwank type radiant energy generator in road building, which well may have been a new use for this particular type of radiant energy generator, should have sought protection on a process for a new use of the improved device as opposed to claiming the device over again and combining it with conventional paving components in the form of an aggregation.

See discussion on new use of old element in Deller's Walker on Patents, Second Edition, section 124.

Extension of the Patent Monopoly

If Neville has discovered here anything that could be considered new, it is that he was the first to appreciate that the radiant energy generator of the type shown in Schwank patent no. 2,775,294 could be used in bituminous concrete road construction.

A recent decision in the First Circuit had the following to say in this connection:

"The most that can be said for Kirk is that he put a known device to a new use in hot water heating systems. Whatever utility and commercial success his device may enjoy cannot save his patent." *American Tube and Controls, Inc. v. General Fittings Company*. 161 United States Patent Quarterly 1 (CCA1).

Similarly, Justice Roberts states in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 that if this patentee invented anything it was an improvement in a coupling device for connecting an old grease pump to a nipple or fitting to introduce lubricant to an automobile bearing. But the patentee claimed in combination not only the coupling device but the old grease pump and nipple or

fitting for an automotive bearing. The Court found that neither the nipple nor the grease pump functioned any differently in the combination from the way they always had and, therefore, the combination of elements was not a patentable combination at all but rather an unpatentable aggregation. The Court held that any other holding would result in an unwarranted extension of the monopoly to include not only the improved coupling device but the parts to which it was physically connected in the claimed combination, namely, the pump and nipple which were no different functionally in such combination. In his opinion Justice Roberts is quoted as follows:

“The invention, if any, lies in the improvement in the coupling device alone.”

In the present case the association of elements claimed in the Neville patent is composed of an old and priorly patented infra-red generator physically disposed on a chassis containing various standard paving components for depositing, spreading and shaping paving material on a road base. Surely, it would seem on the authority of *Lincoln Engineering* that because Neville may have discovered a new use for a recently patented radiant energy generator, to permit him to claim it again in combination with the old components of a road paver, which similarly function no differently due to the presence of the generator, would grant the patentee an unwarranted extension of whatever protectable monopoly he might otherwise legitimately have had to a standard street paver and thus expose paver manufacturers to the possibility of liability for contributory infringement according to the present definition of that term. In referring to the grease pump in place of the paver here, the opinion in *Lincoln Engineering* expressly alludes to such a threat to sellers of pumps.

Commercial Success and the Claimed Invention

The Court of Appeals below largely predicates its finding of invention by Neville on the ground that he was the first after many years of need to fill the long felt want for an improvement in bonding bituminous concrete grown cold to fresh bituminous material deposited against the concrete in heated condition. The respondent says the majority decision lay in the use of positive radiant energy to condition the old material to meet the new. Aside from the fact that this matter was taught in Morecom patent 709,014 and British patent 756,911, as noted by the Court of Appeals, with which teaching Neville was constructively chargeable, *Baldwin-Lima Hamilton Corp. v. Hi-Way Equipment Co.*, *supra*, its conclusion based thereon ignores the fundamental precept in patent law that commercial success and long felt want are factors used to resolve doubt as to patentable invention and not to inject or create such doubt. In this connection, it was stated in *A & P Tea Co. v. Supermarket Corp.*, *supra*, as follows:

"The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability."

More recently the Supreme Court in *Graham v. John Deere Co.*, 383 U. S. 1, 19-20, found as follows:

"Cook Chemical insists, however, that the development of a workable shipper-sprayer eluded Calmar, who had long and unsuccessfully sought to solve the problem. And, further, that the long-felt need in the industry for a device such as Scoggin's together with its wide commercial success supports its patentability . . . However, these factors do not, in

the circumstances of this case, tip the scales of patentability . . .

See also *Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350, 356-7; *Jungersen v. Ostley and Barton Co.*, 335 U. S. 560, 567; *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F. 2d 36, headnotes 4, 10.

If aggregations of elements in the strict sense are either per se unpatentable, as has been the case, or are generally considered unpatentable today due to the improbability of finding unobviousness under 35 U. S. C. 103, it cannot be seen that evidence of commercial success or long felt want relied upon so heavily by the majority below, can establish patentable invention especially when it is considered that all the elements are old and the 1905 patent to Morcom teaches the very advantages of using radiant energy in bonding bituminous asphalt in road work which are taught by Neville though necessarily with an older type radiant energy generator. It is respectfully submitted that it was the availability of propane gas since 1905 in lieu of liquid petroleum then in use which made obvious the feasibility of such generators for mobile use at remote highway locations. The trial testimony of respondent's expert witness was clear on this point (A. 45a).

Both at the trial and during pre-trial discovery, respondent produced experts who declared that heating the cold joint with infra-red heat as opposed to, for example, direct flame produced a remarkably good bond. However, no evidence bearing on success was adduced by respondent in support of invention in the claimed combination of old elements which consisted of pavement material depositing and shaping means in addition to the particular heater employed with such means. The Neville patent claims the entire paver and not just its heater.

The prior art, which was not considered in the Patent Office, discloses that as early as 1905 (Morcom patent no. 799,014) it was known that radiant energy or infra-red heat improved the bond in applying patches of bituminous concrete in asphalt surface repair. The trial record offers an explanation (A. 45a) as to why this knowledge was not put to use for such a long period of time, a consideration in the opinion below used to base its finding that Neville filled the long felt need and that there was, therefore, commercial success. The record below also includes testimony of an expert casting grave doubt as to whether success of any kind is actually present in this case (A. 39a). But other than that the record is quite silent as to the commercial success of the Neville paver as patented as opposed to that of its heat generator.

The district court opinion declared the Neville patent invalid on the ground that the total combination was "reasonably obvious to one possessing ordinary skill in the art" and that the claims were directed to aggregation. The Court below reversed on finding commercial success without considering the question of aggregation and that the proofs thereof were directed to but one element of the aggregation. But Judge Field of the district court anticipated and, in effect, disallowed such a finding by stating in his opinion as follows:

"these witnesses, however, were basing their opinion on the fact that they were doubtful that radiant heat would solve the problem of cold joints. I am of the opinion that this does not get to the heart of validity. *Plaintiff's patent is a combination patent.*"

Old Combination

If one may be permitted to reason by analogy, and somewhat hypothetically, it would surely seem that the interdiction against repatenting an old combination where merely one element thereof has been improved by an alleged inventor, *Bassick Mfg. Co. v. R. M. Hollingshead*, 298 U. S. 415, would apply, *a fortiori*, to a combination which includes an element that has been improved by someone other than the inventor. Such reasoning assumes *arguendo* that the claimed association of elements of Neville is a true combination, an assumption which is, of course, sharply contested by Petitioner.

VII

Conclusion

Petitioner respectfully requests that judgment of the Court below be reversed.

Respectfully submitted,

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Dated: January 30, 1969

